

## **REMARKS**

### **I. BACKGROUND**

Claims 1-18 were pending in the application. Claims 1-18 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,239,867 to Aggarwal (hereinafter "Aggarwal"). Furthermore, claims 3, 10 and 17 are rejected under 35 U.S.C. § 103(a) as being un-patentable over Aggarwal in view of U.S. Patent No. 5,828,405 to Vanier (hereinafter "Vanier"). Claim 16 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. With this paper, the applicant has amended the independent claims 1, 8 and 15, while claims 20-22 are newly added with this paper.

The applicant respectfully traverses the examiner's rejection of claims 1-18 and respectfully requests reconsideration. This amendment is timely filed as it is accompanied by a two month extension of time and the requisite fees, therefore, extending the response date to June 13, 2005 (June 11, 2005 being a Saturday). However, if any additional fee is due, please charge our Deposit Account No. 13-2855, under Order No. 30550/38856A from which the undersigned is authorized to draw.

Furthermore, the applicant and his attorneys thank Examiner Retta for the telephone interview of May 10, 2005.

### **II. CLAIM 1 AND ITS DEPENDENT CLAIMS ARE ALLOWABLE**

Claim 1 recites, among other things, a gemstone evaluation system having an input device adapted to receive a gemstone laboratory grading certificate via a remote communication device, a processing device adapted to compute a pricing estimate for use in an evaluation report and based at least on data included on the gemstone laboratory grading certificate, and an output device adapted to communicate the evaluation report to a system user. Thus, the gemstone evaluation system recited in claim 1 generates a gemstone pricing estimate without a gemstone being physically present to any part of the gemstone evaluation system.

#### **A. Aggarwal Fails To Disclose Creating An Evaluation Report In The Absence Of The Gemstone**

The Aggarwal provisional application does not disclose a gemstone evaluation system that can be used to provide an evaluation report for the gemstone in the absence of the gemstone, in a manner recited by the claim 1. Specifically, while the first page of the

Aggarwal provisional application discloses a method of determining a monetary value of a gemstone relative to the measured spectral response of the gemstone, unlike the automated gemstone evaluation system recited in claim 1, the method disclosed on the first page requires the presence of the gemstone to get its spectral response.

The gemstone evaluation system disclosed in Aggarwal uses a local imaging station to determine various characteristics of a gemstone to be evaluated. For example, such a local imaging station gauges a spectral response of the gemstone subject to plurality of light sources of the imaging station. The physical presence of the gemstone is absolutely necessary in using the gemstone evaluation system disclosed in Aggarwal.

On the other hand the system recited in claim 1 does not require physical presence of the gemstone at all. For example, using the system recited in claim 1, a user can prepare an evaluation report using a gemstone characteristic value communicated to the gemstone evaluation system over a communication network. Moreover, physical presence of the gemstone is not required even for such a remote communication of the gemstone characteristic value as information from a laboratory grading certificate or from a sales receipt of a gemstone may be used to determine such a gemstone characteristic value.

While the examiner has cited page 6 of the Aggarwal provisional application disclosing a database used to store various types of text, graphic, audio and video data and capable of generating a report, it is not clear as to what is the nature of the report, and whether the cited database has any type of information related to a gemstone. Aggarwal certainly does not disclose creating an evaluation report without the presence of a gemstone as described in claim 1. Each of the paragraphs in cols. 1, 2 and 14-16 of the Aggarwal patent, which are cited by the Examiner in rejecting claim 1, note that the physical presence of a gemstone is necessary for its evaluation.

**B. Aggarwal Fails To Disclose Creating An Evaluation Reporting Using Cut Properties**

Similarly, while the examiner suggests that the page 9 of the Aggarwal provisional application discloses a database and an analytical software to produce an appraisal report, it does not disclose producing an evaluation report using cut proportions of the gemstone, as recited in claim 1. Finally, while page 14 of the Aggarwal provisional application discloses that content of a folder are analyzed to prepare an appraisal report, the folder does not include any information about the cut proportions of a gemstone, as used by the automated gemstone

evaluation system recited in claim 1. Thus, the claim rejections based on the Aggarwal provisional application are improper and should be withdrawn, despite the examiner's conclusory statement that "upon review of the provisional application, support exists for the claim limitations."

**C. Aggarwal Is Not Available As Prior Art**

The Aggarwal provisional application is not available as a prior art reference, as it does not contain support for the invention claimed in Aggarwal, as required by 35 U.S.C. §112, first paragraph. See, MPEP § 2136.03 IV, ("Filing Date Of U.S. Patent Application Can Only Be Used As The 35 U.S.C. § 102(E) Date If It Supports The Claims Of The Issued Child"). See also, *In re Wertheim*, 646 F.2d 527, 537 (CCPA 1981):

If, for example, the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains §§ 120/112 support for the invention claimed in the reference patent.

In this case, the examiner has not, and cannot, demonstrate that the Aggarwal provisional application contains support for the invention claimed in the Aggarwal patent. For example, the Aggarwal provisional application contains no support for claims 25-26, 31, or 35 of the Aggarwal patent. Specifically, the claimed element of "generating an appraisal report ... based on the information in the data file," as recited in claim 25 is not present in the Aggarwal provisional application, while the claimed element of "storing the appraisal report in a database of gemstone grading and identification information," as recited in claim 26 is not present in the Aggarwal provisional application. Similarly, the claimed elements of "generating an appraisal report or the gemstone," as recited in claim 31 is not present in the Aggarwal provisional application, while the claimed element of "transaction is selected from the group consisting of marketing of a gemstone, retail or wholesale purchasing or selling of a gemstone," as recited in claim 35 is not present in the Aggarwal provisional application. Accordingly, the Aggarwal patent is not entitled to be used as prior art over the present application.

Moreover, even if both Aggarwal and the Aggarwal provisional application are available as prior art, neither of them discloses any gemstone evaluation system that can be used to provide an evaluation report for the gemstone in the absence of the gemstone and using the cut proportions of the gemstone, in a manner recited by the claim 1.

**D. Vanier Teaches Away Because It Requires The Presence Of The Gemstone**

Vanier discloses a gemstone recordal system that records a unique light pattern of a gemstone, where the recordal system includes a gemstone fixture that orientates a gemstone in a predetermined manner relative to a collimated light beam. See Col. 1, lines 45-60. Apparently, Vanier requires the actual presence of the gemstone being evaluated, and does not use predetermined gemstone data. Also see Figs. 1-2. Thus, because Vanier indicates that the gemstone must be present, and uses gemstone data that is determined concurrently with the evaluation of the gemstone, rather than using predetermined gemstone data, Vanier teaches away from the gemstone evaluation system recited in claims 1.

**III. CLAIMS 8 AND 15 AND THEIR DEPENDENT CLAIMS ARE ALLOWABLE**

Claims 8 and 15 and their dependent claims are allowable much for the same reasons as recited above with respect to claim 1, specifically, that the claimed element of the physical presence of the gemstone not being required is not disclosed in the prior art references.

**IV. CONCLUSION**

It is respectfully submitted that this application is now in condition for allowance. Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application towards allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

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